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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,216	06/16/2000	Thomas E. Ward III	IS/074 CONT 3.	1187
7590	06/30/2005		EXAMINER	
ALEXANDER SHVARTS FISH & NEAVE 1251 AVENUE OF THE AMERICAS NEW YORK, NY 10020-1105			NALEVANKO, CHRISTOPHER R	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/595,216	WARD ET AL.	
	Examiner	Art Unit	
	Christopher R. Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed 04/06/2005 have been fully considered but they are not persuasive.

Regarding Claims 1, 14, and 27, Applicant argues that "the Examiner has failed to provide the proper motivation to combine the references and because even the Examiner's proposed combination of Lajoie with Lawler fails to show or suggest an interactive program guide having a display function with two interchangeable display states. To the contrary, applicants submit that both Laloie and Lawler refer to interactive program guides in which a display function possesses only a single, static display state (i.e., there is no ability in either Laloie or Lawler to switch between multiple display states of a single activated display function)" (page 17 lines 1-10). First, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of LaJoie with the ability to replace the program in the viewing window with a second program, as shown in Lawler, so the user could continue to use the EPG while also tuning to additional interested

channels. Furthermore, LaJoie clearly shows the ability to switch between "display states" (col. 26 lines 15-45, switching between display modes A, B, and C, col. 26 lines 15-46, navigating through different display modes, themes, and channels) and a variety of available display functions. This limitation is extremely broad and encompasses a variety of functions that a user could switch between during manipulation of an EPG screen. LaJoie additionally shows maintaining display of the first television program in the second area of the screen responsive to a first state of the activated display function regardless of user navigation through the displayed program listings (col. 6 lines 55-60, col. 23 lines 55-65, col. 26 lines 15-26, maintaining previously tuned program while using the program guide), which corresponds to the first state. LaJoie merely fails to disclose that the second display state is that the second viewing mode enables a user to scroll to another television program and the program is replaced by the selected program. Lawler clearly states a viewing mode in which activates a function and gives the user the ability to scroll to another television program, the first television signal being replaced by the selected second program (col. 2 lines 50-67, col. 5 lines 30-50, displaying focused program in preview display window). Since LaJoie states the ability for a second "display state" but merely fails to disclose the specific display state in Lawler, there is more than ample motivation to combine. As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of LaJoie with the ability to replace the program in the viewing window with a second program, as shown in Lawler, so the user could continue to use the EPG while also tuning

to additional interested channels. This would allow a user to temporarily view a scrolled to channel so they could identify possible interesting material.

Applicant further argues that “Contrary to the Examiner's contention, applicants submit that the passage referred to by the Examiner merely lists parallel examples of the content that may be displayed in the program viewing window in separate mode screens (i.e., different interactive program display functions) of the Lajoie guide. In fact, there is no showing or that the program viewing window is interchangeable display states in a suggestion in Laloie capable of multiple, single activated display function (i.e., on a single screen). Therefore, Laloie fails to provide any motivation or suggestion for one of ordinary skill in the art to modify its program viewing window to add a second display state that can be switched with the first display state” (page 18 lines 1-11). As stated above, because the limitation of “display states” is an extremely broad limitation, LaJoie clearly shows multiple display states. LaJoie shows the ability to switch between “display states” (col. 26 lines 15-45, switching between display modes A, B, and C, col. 26 lines 15-46, navigating through different display modes, themes, and channels) and a variety of available display functions. Additionally, even as admitted by the Applicants, in col. 6 lines 56-67, LaJoie shows that a variety of different programs and modes may be used to display program in a different *mode*. The use of a different mode can be read on the limitation of a “display state.” Furthermore, there is nothing in the claimed limitations that require “interchangeable display states...capable of multiple, single activated display functions.” This is distinct and extremely different language than what is used in the claimed limitations. Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, and as discussed above, LaJoie provides ample motivation to combine.

Applicant argues that “applicants submit that Lawler similarly fails to show or suggest that the preview display window has multiple, distinct and interchangeable display states” (page 18 lines 19-22). Lawler is not used to show multiple display states. This argument has been addressed in the above paragraphs with regards to LaJoie.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-9, 12-17, 19-22, 25-30, and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al (5,850,218) in further view of Lawler et al (5,907,323).

Regarding Claim 1, LaJoie shows a method for navigating about an on screen television interactive program guide (fig. 16). LaJoie further shows displaying program listings for a plurality of currently broadcast television programs in a first area (fig. 16), simultaneously displaying a first television program in a second area of the screen (fig. 16 item 340, col. 6 lines 45-67, col. 23 lines 45-65), activating a display function (col. 23,

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lines 60-67, col. 24 lines 35-50, col. 26 lines 15-45, col. 27 lines 10-61, navigating through the EPG and switching display modes), and maintaining display of the first television program in the second area of the screen responsive to a first state of the activated display function regardless of user navigation through the displayed program listings (col. 6 lines 55-60, col. 23 lines 55-65, col. 26 lines 15-26, maintaining previously tuned program while using the program guide). Furthermore, LaJoie shows a variety of display functioning modes that dictate how video and data are displayed and switching between these functions (col. 26 lines 15-46, navigating through different display modes, themes, and channels). Also, LaJoie suggests that the program in the viewing window, or PIP display, can be changed by activating a second function but does not specifically disclose this mode (col. 6 lines 55-61, "the program viewing window may...display a program selected from the interactive program guide"). LaJoie fails to specifically state that the second viewing mode enables a user to scroll to another television program and the program is replaced by the selected program. Lawler clearly states that the currently broadcast television program corresponding to a television program listing selected in the scrolling area is displayed in the display window (col. 2 lines 50-67, col. 5 lines 30-50, displaying focused program in preview display window). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of LaJoie with the ability to replace the program in the viewing window with a second program so the user could continue to use the EPG while also tuning to additional interested channels.

Regarding Claim 2, LaJoie shows an icon (fig. 16, displaying a variety of function indicators, items 360, 362, and 364, etc.) that indicates the user is in the program guide display.

Regarding Claim 3, LaJoie shows an a variety of icons overlayed on multiple portions of the screen (fig. 16, displaying a variety of function indicators, items 360, 362, and 364, etc.). Specifically, LaJoie shows icons indicating time and channel information, which are “states” of the display function (fig. 16 item 342).

Regarding Claim 4, LaJoie further shows receiving a first user command invoking a full screen television mode from the on screen guide (col. 26 lines 15-25), displaying a full screen television program in response to the first user command (col. 26 lines 15-25), receiving a second user command invoking a grid guide mode (fig. 18, pressing “guide” button, col. 25 lines 60-67), returning to the on screen program guide (fig. 18, pressing “guide” button, col. 25 lines 60-67), and redisplaying the first television program in the second area of the screen (fig. 18).

Regarding Claim 6, LaJoie shows that user activates the display function with a remote control (fig. 3 item 59, col. 15 lines 55-67).

Regarding Claim 7, LaJoie shows that the list of television programs in the first area is maintained while activating a variety of display functions (col. 6 lines 45-67, col. 23 lines 45-67, col. 26 lines 26-45, col. 27 lines 35-62, col. 30 lines 12-30, selecting different modes and requesting additional information).

Regarding Claim 8, LaJoie shows displaying an interactive advertisement in a third area of the screen (fig. 16 items 378, advertisement on future programming) and

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selecting the advertisement to activate an ad function (fig. 24, col. 29 lines 5-60, recording a advertised future program).

Regarding Claim 9, LaJoie shows selecting the advertisement to activate storing the time and channel for future record (fig. 24, col. 29 lines 5-60, recording a advertised future program).

Regarding Claim 12, LaJoie and Lawler fail to show the ability to collect user profile data and use this data to select advertisements. Official Notice is given that it is well known and expected in the art to use a user profile to select relevant advertisements. This allows the system to present the user with the most relevant data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LaJoie and Lawler with the ability to user a profile to select advertisements so that the system would present the user with data that the user found interesting.

Regarding Claim 13, LaJoie and Lawler fail to show collecting data regarding viewing characteristics and viewer interactions. Official Notice is given that it is well known and expected in the art to collect data regarding viewing characteristics and viewer interactions. This provides the system with relevant facts about the user that can be used for data processing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LaJoie and Lawler with the ability to collect certain user characteristics so that the system would present the user with data that the user found interesting.

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Regarding Claim 14, LaJoie shows an interactive television system with a tuner for receiving a television program, memory for storing multiple types of data, and a display monitor coupled to the tuner and memory (fig. 3 item 41 tuner, item 32 memory, fig. 16 display). All other limitations of the Claim have been discussed with regards to the method claims of Claim 1.

Regarding Claims 15-17, 19-22, 25, and 26, the system claims have been discussed with regards to the method Claims of Claims 2-4, 6-9, 12, and 13, respectively.

Regarding Claim 27, all limitations of the claim have been discussed with regards to Claim 1.

Regarding Claim 28, all limitations of the claim have been discussed with regards to Claim 2.

Regarding Claim 29, all limitations of the claim have been discussed with regards to Claim 3.

Regarding Claim 30, all limitations of the claim have been discussed with regards to Claim 4.

Regarding Claim 32, all limitations of the claim have been discussed with regards to Claim 6.

Regarding Claim 33, LaJoie shows that user activates the display function with an icon (fig. 16, items 360-364, activating different display functions).

Regarding Claim 34, LaJoie shows that the list of television programs in the first area is maintained while activating a variety of display functions (col. 6 lines 45-67, col.

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23 lines 45-67, col. 26 lines 26-45, col. 27 lines 35-62, col. 30 lines 12-30, selecting different modes and requesting additional information).

Regarding Claims 35-37, LaJoie shows that the video screen is inlaid in the EPG graphics, which is a picture in picture display (fig. 16 item 340).

3. Claim 5, 18, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al in further view of Lawler et al (5,907,323) and Alten et al (2002/0049973).

Regarding Claim 5, LaJoie shows a variety of icons representing display functions (fig. 16). LaJoie and Lawler fail to show a locked lock and an unlocked lock to indicate the display state. Alten shows a lock in a locked position to indicate certain display functions (figs. 7 and 41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LaJoie and Lawler with the ability to use a lock icon to show certain display functions so that the user would have a clear, visual representation of a selected function.

Regarding Claim 18 and 31, all limitations of the claim have been discussed with regards to Claim 5.

4. Claims 10, 11, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaJoie et al in further view of Lawler et al (5,907,323) and Shoff et al (2001/0001160).

Regarding Claim 10, LaJoie shows the ability to connect to the Internet (abstract). Both LaJoie and Lawler fail to show that an ad function is establishing a link to the a website for display of still images. Shoff shows connecting to an advertisement website to display images (page 7 sections 0077-0078, fig. 8c). Furthermore, a variety of data is

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in a “third area” of the screen. It would have been obvious to one of ordinary skill in the art to modify the system of LaJoie and Lawler with the ability to show information from a website regarding an advertisement so that a user could be presented with purchasable items and services, increasing the profitability of the system.

Regarding Claim 11, LaJoie shows the ability to connect to the Internet (abstract). Both LaJoie and Lawler fail to show that an ad function is establishing a link to the a website for display of still images. Shoff shows connecting to an advertisement website to display images (page 7 sections 0077-0078, fig. 8c). Furthermore, a variety of advertisement data is shown in a number of different areas. It would have been obvious to one of ordinary skill in the art to modify the system of LaJoie and Lawler with the ability to show information from a website regarding an advertisement so that a user could be presented with purchasable items and services, increasing the profitability of the system.

Regarding Claims 23 and 24, the limitations of the claims have been discussed with regards to Claims 10 and 11, respectively.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Nalevanko whose telephone number is 571-272-7299. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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